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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,108	01/21/2004	Tao Wang	CT-2731A CIP1	3882
23914	7590	02/15/2007	EXAMINER	
LOUIS J. WILLE BRISTOL-MYERS SQUIBB COMPANY PATENT DEPARTMENT P O BOX 4000 PRINCETON, NJ 08543-4000			DENTZ, BERNARD I	
			ART UNIT	PAPER NUMBER
			1625	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/15/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/762,108	WANG ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Bernard Dentz	1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 31 August 2006.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-93 is/are pending in the application.  
4a) Of the above claim(s) 16,18,20,22-24,42-47,49-51,53-61 and 70-86 is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1 and 87-93 is/are rejected.  
7)  Claim(s) 2-15,17,19,21,25-41,48,52 and 62-69 is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_\_

Applicants have elected the compound of Ex. 2. In that compound none of the substituents which correspond to A, B and D of the generic Markush claim are heteroaryl.

A new restriction requirement is made below.

In the restriction requirement below although compounds are recited, the claims to the pharmaceutical compositions and methods wherein said compound is the active ingredient are included.

Restriction is required as follows:

I. Claims 1-15,17,19,21,23,25-41,48,52,62-69 and 87-93 drawn to compounds where none of the substituents A, B and D are attached to the carbon of the main nucleus of the compound through a "heteroaryl" value.

II. Claims 1-15, 17, 19,21,23,25-41,48,52,62-69 and 87-93 in part and 16, 18,22,24, 42-47, 49-51, 53-61 and 70-86 in full where at least 1 of A, B and/or D is attached to said carbon through a heteroaryl value.

The above Gps. are classified differently and there is no common core in the vastly broad generic claim . Very important in the decision for restriction is the fact that some of the heterocyclic values are provisoed out in view of WO 97/24350 cited by applicants. Thus different patentability considerations apply to the heteroaryl values and the non-heteroaryl values for these groups.

Applicants election of the above mentioned species represents a constructive election of Gp. I.

Non-elected claims 16, 18,20,22-24,42-47,49-51,53-61 and 70-86 are withdrawn from consideration.

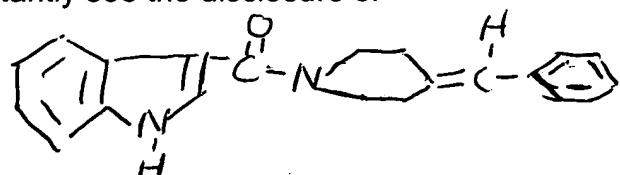
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 88, 90 and 92 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 02/04440, cited by applicants. It discloses for use against infection by HIV a genus of 3-(4-substituted-piperidin-1-ylcarbonyl) indoles, which may be substituted by a single substituent on the benzo part of the indole moiety, wherein the 4-substituent can be arylalkenyl. See formula I and the description thereunder at p. 4. For the utility against HIV see p. 14, line 32 to p. 15, line 7.

Very importantly see the disclosure of



As one of the active compounds at p. 8, line 2 and its synthesis in Ex. 8 at p. 28.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 88-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/28292. The compounds and their compositions and corresponding method of use claims are obvious when homologous compounds are recited differing from the above e.g. by containing an alkyl(s) on the indole nucleus or attached to the A phenyl group or as a value for D.

Of course the instant method of use claims 89 and 91-93 wherein an another active anti-HIV compound is included in the treatment are deemed to be obvious since mixtures of drugs are common in the treatment of AIDS.

Claim 87 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is improper to refer to the specification as is done here "a compound selected from Examples 1-121".

Claims 1-15,17,19,21,23,25-41,48-52,62-69 and 87-93 are objected to for containing non-elected subject matter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernard Dentz whose telephone number is 571-272-0683. The examiner can normally be reached on Mon-Fri from 8 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie, can be reached on 571 272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dentz

2-7-2006



BERNARD DENTZ  
PRIMARY EXAMINER